

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/26/2010 has been entered.

### ***Remarks***

2. The present Office Action is based upon the Applicant's amendment filed on 07/26/2010. **Claims 13, 15-20 and 22-26** are now pending in the present application.

### ***Response to Arguments***

3. Applicants' arguments with respect to rejections under 35 USC § 112, first paragraph, are not persuasive (see rejection under 35 U.S.C. 112, the first paragraph). Applicant's arguments from page 7 to 9 are unclear and vague. Applicant's response lacks the clarity and certainty to describe where in the specification discloses the limitations, "a third party service provided by a third party", "establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service" and "the third party service comprises access to one or more applications".

As Applicants indicate, on the last paragraph of in page 7 of the Applicant's arguments/remarks, "to satisfy the written description requirement, all that is required is

'reasonable clarity' (MPEP 2163.02)". However, it is unclear for one skilled in the art to conclude that the current specification discloses, "a third party service provided by a third party", "establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service" and "the third party service comprises access to one or more applications".

to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))...

The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C.112, first paragraph – description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate. (SEE MPEP 2163.02)

The amended claim(s) includes limitations or terminologies which are not presented in the current specification.

Applicants argue, "one of ordinary skill in the art would reasonably conclude that Applicants' disclosure, including the teachings noted by the Examiner along with other teachings of the specification, adequately described the claim limitations regarding the

'third party service.'" Examiner respectfully disagrees. It is questionable how one skilled in art can conclude Applicants' disclosure adequately described the claim limitations.

Applicants further argue that 1) If access to these applications (i.e. "Airport," "Station," "Hotel, Luxury Category," "Hotel, Midrange Category," and "Coffee Shop") has to be *granted*, then inherently these are applications from another party than the one claiming access, and 2) As airports, stations, hotels and coffee shops are usually not run by mobile radio providers but rather by other companies, the applications named for these areas are not offered by the mobile radio providers but rather by the companies providing services in these areas. Examiner respectfully disagrees. Even by accepting these Applicant descriptions (which are not), then it is unclear what the limitation:

"wherein the third party service comprises access to one or more applications offered at the location," and

"establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network"

If applications are "Airport," "Station," "Hotel, Luxury Category," "Hotel, Midrange Category," and "Coffee Shop", and inherently these are applications from another party then how these applications access to one or more applications offered at the location?; and where in the specification discloses the limitation? It is unclear "Airport," "Station," "Hotel, Luxury Category," "Hotel, Midrange Category," and "Coffee Shop", are applications, a service that provides access to application, or locations.

On page 9 of the Applicants' arguments/remarks, Applicant further argues, "one of ordinary skill in the art would reasonably consider an 'access point' as a 'service

provided by a third party"; Examiner respectfully disagrees. On ordinary skill in the art consider an "access point" as connection point to receive access to internet, data, voice or specific type of service; and it is not necessary that an 'access point' as a 'service provided by a third party' since the access point could be a personal or private WLAN.

Applicants further argues, 2) based on (a) the phrase 'to use *in part*' in paragraph 0003 and/or (b) the fact that according to WLAN a station is associated with one access points out of multiple access points, one of ordinary skill in the art would reasonably conclude that the limitation 'establishing and permitting a connection to a local wireless network to receive *at least a portion* of the third party service' is adequately supported". Examiner respectfully disagrees. It is questionable how Applicants conclude this statement. Par. 0003 of the Background section indicates the free WLAN access points are used as part of public access; and it does not mean "establishing and permitting a connection to a local wireless network to receive *at least a portion* of the third party service' with consideration of the pervious limitation, "a third item of network, information indicating at least one third party service provided by a third party via the local area network, wherein the third party service comprises access to one or more applications offered at the location"

Applicants further argue, "3} one of ordinary skill in the art would reasonably consider 'free WLAN .... add-on to UMTS' (paragraph 0003) as 'at least one application,' thus adequately supporting the limitation 'the third party service comprises access to one or more applications.'" Examiner respectfully disagrees with Applicants. As indicated above, it is unclear "Airport," "Station," "Hotel, Luxury Category," "Hotel,

Midrange Category,” and “Coffee Shop”, are applications, a service that provides access to application, or locations.

One skilled in the art knows, “Airport,” “Station,” “Hotel, Luxury Category,” “Hotel, Midrange Category,” and “Coffee Shop” are **locations** that can provide a service to users. Examiner considers the Applicants' definition of “applications” in the specification as WLAN “locations” unique codes (see par. 0086, 0095-00101).

Furthermore, Applicant fails to provide any reason where in the specification the limitation(s), **“based at least on the first, second, third, and fourth items of network information..., establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network.”**

4. Applicant's arguments with respect to claims 13, 15-20 and 22-26 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

5. **Claim 19** is objected to because of the following informalities:

a) On **line 2 of claim 19**, insert --one-- before “first” (since only the “at least one first item” is defined in line 4 of the claim 13);

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 13, 15-19, 20 and 22-26** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 13, 20, and 26 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite, "a third item of network information indicating *at least one third party service* provided by **a third party via** the local area network... *wherein the third party service comprises access to one or more applications offered at the location, and based at least on the first, second, third, and fourth items of network information* stored in the same item of identification information, *establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network.*" However, there is nothing the specification to disclose "a third party service provided by a third party", "establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service" and "the third party service comprises access to one or more applications".

Applicant is welcomed to point out where in the specification supports the limitations and his argument.

In contrast, par. 0015 of the specification merely discloses, "a third item of information about *at least one service* provided by the local area network"; par. 0086, merely discloses, "the WLAN Application Code (WAC) comprises a maximum of three

digits (decimal) and uniquely identifies the WLAN *application*"; and par. 0095-00101 and 00105 and 00106 only discloses the Application codes such as Airport, Hotel, Station or Coffee Shop. There is nothing to disclose about "the service and application provided or offered by the third party".

**Claims 15-19 and 22-25** are also rejected by the virtue of their dependency on **claims 13 and 20**.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. **Claims 13, 17, 19, 20, 24 and 26** are rejected under 35 U.S.C. 102(e) as being anticipated by **Ahmavaara et al. (US Patent Application Publication # 20040066756 A1)** (hereinafter Ahmavaara).

Consider **claim 13**, Ahmavaara discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network (par. 0007, 0073-0076 for cellular and WLAN systems with

identifications associated with SIM or USIM), the second item of identification information comprising:

a first item of network information indicating the location of the local area network (par. 0017, 0041 and 0037 for MNC),

a second item of network information indicating the type of the local area network (par. 0017, 0039 and 0037 for PLMN type of network SSIDs), and

a third item of network information indicating at least one third party service provided by a third party via the local area network (par. 0017, 0042), wherein the third party service comprises access to one or more applications offered at the location (par. 0016, 0032, 0092-0095, the application is considered as the connectivity from public WLAN networks, where any inherent service such as interworking with cellular system can be provided from the connected public WLAN network); and

a fourth item of network information uniquely identifying the local area network (par. 0017 and 0043);

wherein the first, second, third, and fourth items of network information are stored in the same item of identification information (par. 0037 and 0036); and

based at least on the first, second, third, and fourth items of network information stored in the same item of identification information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network (par. 0019, and par. 0091).



Consider **claim 20**, Ahmavaara discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network (par. 0007, 0073-0076 for cellular and WLAN systems with identifications associated with SIM or USIM), the second item of identification information comprising:

a first item of network information indicating the location of the local area network (par. 0017, 0041 and 0037 for MNC),

a second item of network information indicating the type of the local area network (par. 0017, 0039 and 0037 for PLMN type of network SSIDs), and

a third item of network information indicating at least one third party service provided by a third party via the local area network (par. 0017, 0042), wherein the third party service comprises access to one or more applications offered at the location (par. 0016, 0032, 0092-0095, the application is considered as the connectivity from public WLAN networks, where any inherent service such as interworking with cellular system can be provided from the connected public WLAN network); and

a fourth item of network information uniquely identifying the local area network (par. 0017 and 0043);

wherein the first, second, third, and fourth items of network information are stored in the same item of identification information (par. 0037 and 0036); and

requesting a connection to the local wireless network via the terminal (par. 0015);  
accessing the stored information (par. 0015); and  
based at least on the first, second, third, and fourth items of network information stored in the same item of identification information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network (par. 0019, and par. 0091).

Consider **claims 17 and 24 as applied to claims 13 and 20 above respectively**, and Ahmavaara further discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network (par. 0058, 0061 and 0076).

Consider **claim 19 as applied to claim 13 above**, and Ahmavaara further discloses the at least first item of access information is stored on a device serving for user identification, in particular a USIM module (par. 0007, 0075-0076).

Consider **claim 26**, Ahmavaara discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:  
storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile

radio communication system, and at least one second item of identification information for a local area network (par. 0007, 0073-0076 for cellular and WLAN systems with identifications associated with SIM or USIM), the second item of identification information comprising:

- a first item of network information indicating the location of the local area network based on a mobile country code that uniquely identifies the country in which the local area network is operated (par. 0017, 0041 and 0037 for MNC),

- a second item of network information uniquely indicating the type of the local area network (par. 0017, 0039 and 0037 for PLMN type of network SSIDs),

- a third item of network information uniquely indicating at least one third party service provided by a third party via the local area network (par. 0017, 0042), wherein the third party service comprises access to one or more applications offered at the location (par. 0016, 0032, 0092-0095, the application is considered as the connectivity from public WLAN networks, where any inherent service such as interworking with cellular system can be provided from the connected public WLAN network), and

- a fourth item of network information uniquely identifying the local area network so that subscribers may be permitted access (par. 0017 and 0043);

wherein the first, second, third, and fourth items of network information are stored in the same item of identification information (par. 0037 and 0036); and

based at least on the first, second, third, and fourth items of network information stored in the same item of identification information, establishing and permitting a

connection to a local wireless network to receive at least a portion of the third party service via the local area network (par. 0019, and par. 0091).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

A. **Claims 15, 16, 22, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ahmavaara et al. (US Patent Application Publication # 20040066756 A1)** (hereinafter Ahmavaara).

Consider **claims 15 and 22 as applied to claim 13 and 20 above respectively**, Ahmavaara discloses the claimed invention except the first, second, and/or third items of network information are encoded by means of a maximum of three decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

Consider **claims 16 and 23 as applied to claim 14 and 21 above respectively**, Ahmavaara discloses the claimed invention except the fourth item of network information is encoded by means of a maximum of five decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

B. **Claims 18 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ahmavaara et al. (US Patent Application Publication # 20040066756 A1)** (hereinafter Ahmavaara) in view of **Haverinen et al. (US Patent Application Pub. # 20030119481)** (hereinafter Haverinen).

Consider **claims 18 and 25 as applied to claim 14 and 20 above respectively**, Ahmavaara discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of forbidden network IDs as taught by Haverinen to the list of SSIDs or a PLMN preference list as disclosed by Ahmavaara for purpose of authenticating and authorizing a mobile connection to a specific network.

### ***Conclusion***

9. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Allahyar Kasraian whose telephone number is (571) 270-1772. The Examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Allahyar Kasraian/

Examiner, Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617